REMARKS

I.   Introduction

In a non-final Office Action mailed on May 15, 2009, the Examiner rejected claims 1-2 and 5-14 under 35 U.S.C. § 103(a) over a combination of U.S. Patent No. 6,225,995 ("Jacobs"), U.S. Patent No. 6,389,467 ("Eyal"), and U.S. Patent No. 6,418,441 ("Call"), and rejected claim 3 under 35 U.S.C. § 103(a) over a combination of Jacobs, Eyal, Call, and U.S. Patent No. 6,584,468 ("Gabriel"). Applicants herein cancel claims 11-12, add new claims 22-32, and amend claims 1-3, 5, 8, and 13-14 to more clearly identify the subject matter for which applicants seek protection. As a result, claims 1-3, 5-10, 13-14, and 22-32 are now pending.

Applicants would like to thank Examiner Bashore for his consideration during the interview of August 13, 2009. During the interview, Examiner Bashore and applicants' undersigned representative discussed the amendment to independent claim 1 and new claim 23. No agreement was reached; however, Examiner Bashore agreed to contact the undersigned representative to further discuss the claims and cited references after a formal amendment is filed. Applicants respectfully request that Examiner Bashore contact the undersigned representative if he believes that any additional information regarding the interview is necessary. For reasons discussed in detail below, applicants respectfully submit that the pending claims are in condition for allowance.

II.   Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3 and 5-14 under 35 U.S.C. § 103(a) over combinations of Jacobs, Eyal, Call, and Gabriel. Applicants respectfully traverse these rejections and submit that the cited references, individually and in combination, fail to disclose or suggest the elements recited by independent claims 1, 13, and 28.

A.   The cited references fail to disclose or suggest adding identified metadata
       that is associated with all of two or more of the analyzed fields to original
       metadata associated with a streaming media file

The Examiner assets that Jacobs discloses "adding said associated metadata to said original metadata in said database" (Office Action, May 15, 2009, p. 1). In particular, the Examiner states:

> Jacobs teaches *adding said associated metadata to said original metadata in said database*. The Examiner characterizes the claimed invention as modifying metadata this is already stored in the database. For example, Jacobs discloses a method for incorporating state information into a URL where the transaction manager sends a commit request to database server and for causing to cause [sic] changes in response to various browser requests to be committed in the database (col 27, line 65 – col 28, line 3), using the previously stored metadata (col 28, lines 26-29). Since the database already contains metadata, the new data that causes change in the database is interpreted as adding onto the already existing data in the database.

(*id.*; emphasis original). Applicants respectfully disagree. First, the claimed invention cannot be characterized as merely a modification of metadata that is already stored in the database. According to § 2141.02 of the Manual of Patent Examining Procedure (MPEP), the question under 35 U.S.C. § 103 in determining the differences between the prior art and the claims is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (MPEP § 2141.02 citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983)). Moreover, distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole" (*id.* citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). Applicants' claimed invention is directed to enhancing the quality of metadata that is associated with media files. For example, according to one embodiment, when a search system finds a streaming media file, the search system enhances the metadata associated with the streaming media which is stored in a database by adding to the database the additional metadata derived from the contents

of the fields in the Uniform Resource Indicator (URI) of the streaming media file. Accordingly, applicants' claimed invention amounts to much more than merely a modification of metadata that is already stored in the database.

Second, contrary to the Examiner's position, Jacobs does not teach or suggest "adding said identified metadata [that is associated with all of two or more of said analyzed fields] to said original metadata in said database" as recited by claim 1. Jacobs describes metadata in two contexts: cartridge configuration information and transaction information (Jacobs 9:17-57, 19:1-64). Regarding Jacobs' configuration information, Jacobs describes a configuration manager that stores the configuration information during the registration of cartridges (*id*. 9:17-57, Figure 6). This metadata may include the cartridge name, the location of the code that implements the cartridge, etc. (*id*). Jacobs contains no indication of adding metadata, or anything similar, to the stored configuration information in a database (which the Examiner appears to equate to original metadata). Regarding Jacobs' transaction information, Jacobs describes that transaction information for a particular type of transaction includes a cartridge name that identifies a particular cartridge (i.e., software module) that is used to perform the requested transaction (*id*. 19:35-65). The transaction information may also include, for example, a resource-list that identifies the resources (e.g., databases) that are affected by the performance of the requested transaction (*id*). According to Jacobs, for each type of transaction, the transaction information is stored in the cartridge execution engine of the cartridge associated with the transaction type (*id*. 14:48-15:12, 22:16-65, 28:26-29). When a browser request is received, Jacobs identifies the cartridge associated with the browser request by mapping the cartridge name (included in the browser request) to a type of transaction (*id*. 10:1-10, 19:47-51, 21:42-56, 23:67-24:3). Jacobs further uses the stored metadata associated with the requested transaction to, for example, open connections with the databases identified in the resource-list of the transaction information (*id*. 21:57-65). Jacobs contains no indication of adding any metadata to the transaction information of the cartridge execution engine. Indeed, Jacobs describes nothing similar to applicants' recited approach of adding identified

metadata [that is associated with all of two or more of said analyzed fields] to said original metadata in said database" as recited by claim 1.

Furthermore, applicants are perplexed as to how the Examiner arrives at the conclusion that "[s]ince the database already contains metadata, the new data that causes change in the database is interpreted as adding onto the already existing data in the database" (Office Action, May 15, 2009, p. 1). Jacobs clearly explains that the commit request that is sent to the database servers "cause[s] all changes made in response to the various browser requests that belonged to the multiple-request transaction to be committed as an atomic unit of work" (Jacobs 27:65-28:3). The changes to the database result from committing a multiple-request database operation. Jacobs contains no indication that the changes to the database that result from committing the multiple-request database operation as an atomic unit of work involve adding to the stored configuration information or transaction information. Simply put, a change in the database resulting from a database operation as disclosed by Jacobs does not teach or suggest adding the identified metadata to the original metadata associated with a streaming media file, as recited.

The Examiner further states that:

> The Examiner interprets Jacobs' URI portions transaction and cartridge as equivalent to the claimed metadata fields. The Examiner interprets the revision of the browser message as equivalent to the metadata that is added to the associated original metadata because the dispatcher revises the browser upon locating more information that is associated with the cartridge.

(Office Action, May 15, 2009, pp. 2, 6). Applicants respectfully disagree. The Examiner's position is illogical: using the stored metadata to generate a revised browser message is not the same as adding identified metadata to original metadata in a database, as recited. Jacobs clearly indicates that the revised browser request simply repackages information received in the original browser message (Jacobs 9:5-6 23:28-53). As discussed above, Jacobs contains no indication of adding metadata that is

contained in a browser request to any stored metadata. This is consistent with Jacobs' stated purpose of having the server remaining stateless by not persistently maintaining the state information which is unknowingly maintained by the clients making the requests (*id.* 32:44-55).

For at least these reasons, applicants submit that independent claim 1 and each of its dependent claims are patentable over the cited references. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-2 and 5-10 under 35 U.S.C. § 103(a) over the combination of Jacobs, Eyal, and Call, and the rejection of claim 3 under 35 U.C.S. § 103(a) over the combination of Jacobs, Eyal, Call, and Gabriel.

Independent claim 13 recites "means for causing said processor to add said identified metadata [that is associated with all of two or more of said analyzed fields] to said original metadata in a database." New independent claim 28 recites computer-executable instructions to "add the identified metadata [that is associated with all of two or more of the analyzed fields] to the original metadata associated with the media file." For reasons similar to those discussed above with respect to independent claim 1, applicants submit that independent claims 13 and 28, and each of their dependent claims, are also patentable over the cited references. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 13-14 under 35 U.S.C. § 103(a) over the combination of Jacobs, Eyal, and Call.

B.   The cited references fail to disclose or suggest analyzing two or more fields of the plurality of fields of a URI to determine if an association exists between the analyzed fields and predetermined sets of metadata

The Examiner assets that Jacobs discloses "analyzing each field of said plurality of fields of said URI associated with said streaming media file" (Office Action, May 15, 2009, pp. 1-2). In particular, the Examiner states:

> Jacobs teaches *analyzing each field of said plurality of fields of said URI associated with a file; identifying metadata that is associated with said each analyzed field; and adding said associated metadata to original metadata in said database.* For example, Jacobs discloses a URI portion that includes transaction state information and cartridge engine information, which is used to identify the state of multiple-request transactions, the metadata associated with the browser request, where upon receiving the browser request, the dispatcher forwards the URI information to the virtual path manager to locate a pointer to a cartridge associated with the browser request and then send a revised browser message to the cartridge instance (col 21, lines 40 – col 22, line 15).
>
> Additionally, Jacobs discloses identifying previously stored metadata for a transaction associated with the revised browser message associated with a commit transaction URI (col 26, lines 44-48).

(*id.*; emphasis original). Applicants respectfully disagree. Although Jacobs identifies the cartridge associated with the browser request by mapping the cartridge name (included in the browser request) to a type of transaction (Jacobs 10:1-10, 19:47-51, 21:42-56, 23:67-24:3), Jacobs does not teach or suggest "analyzing two or more fileds of said plurality of fields of said URI...to determine if an association exists between said analyzed fields and predetermined sets of metadata" as recited by claim 1. Rather, Jacobs performs a simple lookup using the cartridge name to identify the requested transaction type and associated transaction information. For at least this reason, applicants submit that independent claim 1 and each of its dependent claims are patentable over the cited references. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-2 and 5-10 under 35 U.S.C. § 103(a) over the combination of Jacobs, Eyal, and Call, and the rejection of claim 3 under 35 U.C.S. § 103(a) over the combination of Jacobs, Eyal, Call, and Gabriel.

Independent claim 13 recites "means for causing said processor to analyze two or more fields of said reorganized plurality of fields of said URI to determine if an association exists between said analyzed fields and predetermined sets of metadata." New independent claim 28 recites computer-executable instructions to "analyze two or more fields of the plurality of fields of the URI associated with the media file to

determine if an association exists between the analyzed fields and predetermined sets of metadata." For reasons similar to those discussed above with respect to independent claim 1, applicants submit that independent claims 13 and 28, and each of their dependent claims, are also patentable over the cited references. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 13-14 under 35 U.S.C. § 103(a) over the combination of Jacobs, Eyal, and Call.

C.   The cited references fail to disclose or suggest reorganizing the plurality of fields of a URI associated with a media file

The Examiner asserts that Eyal discloses "means for causing said processor to reorganize said plurality of fields of said URI associated with said streaming media file" as recited by independent claim 13 (Office Action, May 15, 2009, p. 7). In particular, the Examiner states:

> Specifically, Eyal teaches adding the URL (and metadata) of the selected medial [sic] clip to store, where the user can change the order of the play-list stored on the network server and accessed using the medial [sic] location and playback module (col 31, line 65 – col [3]2, line 25). The examiner interpret [sic] reordering of the play-list as equivalent to reorganizing the fields because reordering of data organized data in a different manner and Eyal teaches doing this reordering process for URL (and related metadata).

(id). Applicants respectfully disagree. Independent claim 13 recites "means for causing said processor to reorganize said plurality of fields of said URI associated with said streaming media file" (emphasis added). Eyal clearly explains that a play-list contains the verified media links, which are verified URLs (Eyal 12:28-29, 64-67). Accordingly, changing the order of Eyal's play-list merely amounts to changing the order of the URLs contained in the play-list without changing the content of any URL or URI (Eyal, 32:12-13). Therefore, contrary to the Examiner's position, changing the ordering of multiple URLs cannot be interpreted as being equivalent to reorganizing the fields of a single URI (URL), as recited. For at least this reason, applicants submit that independent claim 13 and dependent claim 14 are patentable over the cited references. Accordingly,

applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 13-14 under 35 U.S.C. § 103(a) over the combination of Jacobs, Eyal, and Call.

D.   The cited references teach away from their combination

To establish a prima facie case of obviousness, the Examiner must show that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue" (*KSR Int'l Co.*, 127 S. Ct. at 1740-41). The Examiner's analysis "should be made explicit" (*id*). That is, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*id. citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious" (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

The Examiner asserts that one would be motivated to combine Jacobs, Eyal, and Call to "provid[e] the benefit of providing streaming media on the internet reliably when the number of users accessing the site become congested" and to "provide the benefit of a method for transferring request for specific information to preferred sources of the information on the Internet" (Office Action, May 15, 2009, p. 2). Applicants disagree with this assertion and submit that one skilled in the art would at least not combine Jacobs and Call as suggested by the Examiner, because Jacobs teaches away from combining with references such as Call that teach storing state information in a database. Jacobs specifically states that the server remains stateless by not persistently maintaining the state information retrieved from the URI (Jacobs 32:54-55). Indeed, Jacobs refers to such systems as "wasteful" and non-scalable" (*id*. 2:14-36, 32:9-21, 33:24-34). Thus, one skilled in the art would not modify Jacobs system as

suggested by the Examiner because Jacobs teaches away from such a modification. Moreover, storing state information in a database would change the principle operation of Jacobs' system[1], which provides "a mechanism for processing multiple-request transactions in a stateless environment that <u>does not require a servicing process to maintain transaction state information</u>" (*id*. 2:37-40; emphasis added).

For at least this reason, applicants submit that independent claims 1, 13, and 28 are patentable over the cited references. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-2, 5-10, and 13-14 under 35 U.S.C. § 103(a) over the combination of Jacobs, Eyal, and Call, and the rejection of claim 3 under 35 U.C.S. § 103(a) over the combination of Jacobs, Eyal, Call, and Gabriel.

E.   New dependent claims 22-27 and 30-32

New dependent claims 22-27 and 30-32 recite additional features that further distinguish them over Jacobs, Eyal, Call, and Gabriel. In particular, dependent claims 22-27 and 30-32 each recite a basis used to identify metadata. For example, dependent claims 23, 26, and 31 recite that the two or more analyzed fields for which metadata is identified include only a sequence of contiguous fields of the URI, and dependent claims 24, 27, and 32 recite that the contiguous fields include all of the two or more analyzed fields that have metadata in common and the identified metadata is the common metadata. As another example, For example, dependent claims 22, 25, and 30 recite that the two or more analyzed fields for which metadata is identified include the last field. Applicants can find no disclosure in any of the cited references of the recited basis for identifying metadata. Accordingly, applicants respectfully submit that dependent claims 22-27 and 30-32 are further patentable over Jacobs, Call, Eyal, and Gabriel.

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[1] For example, Jacobs makes clear that "[i]n coordinating the execution of multiple-request transactions, <u>transaction manager retains no state information</u> for the multiple-request transactions" (*id*. 20:32-45; emphasis added).

III. Conclusion

In view of the above amendment and remarks, applicants believe that the pending claims are in condition for allowance. If the Examiner has any questions or believes a telephone conference would expedite examination of this application, the Examiner is encouraged to call the undersigned directly at (206) 359-8077.

Please charge any deficiencies or credit any overpayment to our Deposit Account No. 50-0665, under Order No. 283108005US from which the undersigned is authorized to draw.

Dated: _August 13, 2009_

Respectfully submitted,

By _____
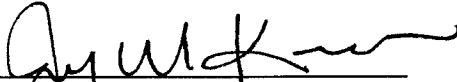
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